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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,570	03/24/2004	Jean-Marc Alexia	S-215	7997

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EXAMINER	
JOSEPH, TONYA S	

ART UNIT	PAPER NUMBER
3628	

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/809,570	ALEXIA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tonya Joseph	3628	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected franking machine and an inkjet printer cartridge, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 05/21/2007.
2. Applicant's election with traverse of a franking machine in the reply filed on 05/21/2007 is acknowledged. The traversal is on the ground(s) that since both are similarly classified in 705/401, that searching both Groups would not appear to be an undue burden. This is not found persuasive because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper..

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 26 and 28-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 26 recites the limitation, "wherein the decrypting means of the print member have a prior knowledge of data identifying said print member". It is unclear to

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what event the knowledge is prior to. For Examination purposes, Examiner is interpreting the decrypting means of the print member to have knowledge of data identifying said print member.

6. The term "thin and flexible" in claims 28-29 is a relative term which renders the claim indefinite. The term "thin and flexible" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For Examination purposes, Examiner is interpreting any printed circuit that is fixed to the print member as meeting the limitations of the claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 19-22, 24 and 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauschinger et al. U.S. patent No. 6,978,255 B1 in view of Pauschinger U.S. Patent No. 6,041,704 in further view of Strand U.S. Pre-Grant Publication No. 2002/0199094 A1.

9. As per Claims 19 and 31, Pauschinger teaches a unit for generating franking data and a unit for printing data connected to said data generating unit and adapted to receive franking data therefrom (see Col. 5 lines 54-61 and Col. 9 lines 47-52), said

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printing unit including at least one member for printing data (see Col. 6 lines 36-41), wherein the franking machine includes: means for obtaining data enabling identification of the print member by the data generating unit in a first communication mode (see Col. 6 lines 63-67; Col. 7 lines 1-2 and 40-44), Pauschinger et al. does not explicitly teach means for generating a signature of the franking data by the data generating unit, means for encrypting the signature of the franking data by the data generating unit, means for sending the franking data and the encrypted signature to the printing unit in a second communication mode, Pauschinger teaches wherein the franking machine includes: means for generating a signature of the franking data by the data generating unit (see Col. 5 lines 3-8), means for encrypting the signature of the franking data by the data generating unit (see Col. 5 lines 36-40), means for sending the franking data and the encrypted signature to the printing unit in a second communication mode, (see Col. 7 lines 54-59). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Pauschinger et al to include the teachings of Pauschinger to allow for the verification of franking imprints as taught in Pauschinger Col. 5 lines 5-7. Pauschinger et al. teaches and means for decrypting the encrypted signature. Pauschinger et al does not explicitly teach decryption performed by the print member. Strand teaches, The conduit cartridge encrypts information sent to an analytical system or an operating facility in communication with the conduit cartridge and can decrypt encrypted information received from an analytical system or an operating facility (see The Abstract of Strand). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of

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Pauschinger et al. and Pauschinger to include the teachings of Strand in order to provide for automated remote analyses, as taught in Strand para. 6 lines 3-4.

10. As per Claim 20, Pauschinger et al; Pauschinger and Strand teach the system of claim 1 as described above. Pauschinger et al. does not explicitly teach, wherein the print member includes means for authenticating data. Strand teaches the print member includes means for authenticating data (see para. 15 lines 29-34; 45-50; 53-54; 60-64 and para. 19 lines 4-20). Pauschinger et al. teaches franking data. It would have been prima facie obvious to one of ordinary skill in the art to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to provide for automated remote analyses, as taught in Strand para. 6 lines 3-4.

11. As per Claim 21, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger does not explicitly teach wherein the print member includes means for verifying the integrity of the franking data. Strand teaches wherein the print member includes means for verifying the integrity of the data (see para. 15 lines 29-34; 45-50; 53-54; 60-64 and para. 19 lines 4-20). Pauschinger et al. teaches franking data. It would have been prima facie obvious to one of ordinary skill in the art to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to provide for automated remote analyses, as taught in Strand para. 6 lines 3-4.

12. As per Claim 22, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger does not explicitly teach wherein the print member includes at least one tag identifying said print member. Strand teaches wherein

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the print member includes at least one tag identifying said print member (see para. 12 lines 6-10). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al and Pauschinger to include the teachings of Strand to aid in the identification of the cartridge. The limitation, "communicates data identifying said member to the data generating unit by radio waves when an electromagnetic field is applied to it" is merely a statement of intended result and as such is afforded little patentable weight.

13. As per Claim 24, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger et al. further teaches, wherein the data-generating unit includes a circuit for receiving identification data (see Col. 6 lines 63-67, Col. 7 lines 1-2 and 40-44, Examiner is interpreting meter able to recognize an identification code word as containing a circuit for receiving identification data).

14. As per Claim 26, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger does not explicitly teach wherein the decrypting means of the print member have knowledge of data identifying said print member. Strand teaches wherein the decrypting means of the print member have knowledge of data identifying said print member (see para. 19 lines 34-44). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to maintain data integrity, as taught in Strand para. 34-44.

15. As per Claim 27, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger et al. does not explicitly teach wherein the

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print member includes a data processing unit that includes the decrypting means.

Strand teaches wherein the print member includes a data processing unit that includes the decrypting means (see para. 15 lines 60-64). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to decrypt transmitted information, as taught in Strand para. 60-69.

16. As per Claim 28, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger et al; does not explicitly teach wherein the decrypting means are fixed to a printed circuit that is fixed to the print member. Strand teaches wherein the decrypting means are fixed to a printed circuit that is fixed to the print member (see (see para. 18 and Fig. 3. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to verify information used by the cartridge, as taught in para. 17 lines 7-10. The limitation "printed" is considered non-functional descriptive material and as such is afforded no patentable weight.

17. As per Claim 29, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger et al; does not explicitly teach wherein the data processing unit is fixed to a circuit that is fixed to the print member. Strand teaches wherein the data processing unit is fixed to a circuit that is fixed to the print member. (see para. 12 lines 6-20 and Fig. 3). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et



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al. and Pauschinger to include the teachings of Strand in order to verify information used by the cartridge, as taught in para. 17 lines 7-10. The limitation "printed" is considered non-functional descriptive material and as such is afforded no patentable weight.

18. As per Claim 30, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger et al. further teaches wherein the print member is an inkjet printer cartridge including at least one print head (see Col. 6 lines 31-41).

19. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pauschinger et al. U.S. Patent No. 6,978,255 B1 in view of Pauschinger U.S. Patent No. 6,041,704 in further view of Strand U.S. Pre-Grant Publication No. 2002/0199094 A1 and Chung U.S. Pre-Grant Publication No. 2003/0006878 A1.

20. As per Claim 23, Pauschinger et al; Pauschinger and Strand teach the system of claim 22 as described above. Pauschinger does not explicitly teach wherein the identification tag includes a substrate fixed permanently to the print member. Strand teaches wherein the identification tag includes a substrate fixed permanently to the print member (see para. 12 lines 6-10, Examiner is interpreting a non-moveable tag located inside the housing of the cartridge as being permanent). Pauschinger does not explicitly teach an identification tag with communication means on the substrate Chung teaches an identification tag with communication means on the substrate (see para. 96). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention

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to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Chung to tag and electronically identify objects as taught in Chung para. 96 lines 1-4.

21. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pauschinger et al. U.S. Patent No. 6,978,255 B1 in view of Pauschinger U.S. Patent No. 6,041,704 in further view of Strand U.S. Pre-Grant Publication No. 2002/0199094 A1 and Gordon et al. U.S. Pre-Grant Publication No. 6,527,170 B1.

22. As per Claim 25, Pauschinger et al; Pauschinger and Strand teach the system of claim 22 as described above. Pauschinger does not explicitly teach wherein the data-generating unit includes an electromagnetic field source. Gordon teaches wherein the data-generating unit includes an electromagnetic field source (see Col. 6 lines 1-9; 30-60 and Col. 7 lines 50-53). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Gordon to obviate the need of visual bar coded indicia, as taught in the Abstract of Gordon.

### ***Conclusion***

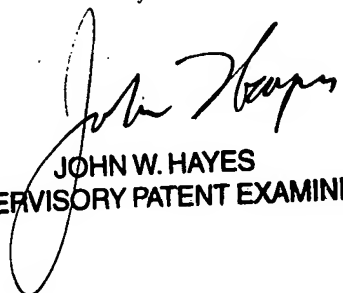
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonya Joseph whose telephone number is 571-270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph  
Examiner  
Art Unit 3628



JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER